

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: May 3, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*StreetCar ORV, LLC d/b/a American Expedition Vehicles*  
*v.*  
*K2 Motor Corp.*

Opposition No. 91248742

Staci R. DeRegnaucourt and Matthew R. Mowers of Quinn IP Law,  
for StreetCar ORV, LLC d/b/a American Expedition Vehicles.

Aaron P. Bradford and Nina P. Brewer of Bradford, LTD,  
for K2 Motor Corp.

Before Kuhlke, Lykos, and Heasley,  
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

K2 Motor Corp. (“Applicant” or “K2”) seeks registration on the Principal Register

of the design mark  for “land vehicle parts, namely, fender flares, bumpers, running boards, side step bar, bull bars, light guards” in International Class 12.<sup>1</sup>

<sup>1</sup> Application Serial No. 88197871 was filed on November 16, 2018, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and in commerce since at least as early as July 2, 2018. In the Application, the mark is described as follows: “The mark consists of an abstract partial body view of a cattle like creature.” Color is not claimed as a feature of the mark.

StreetCar ORV, LLC, doing business as American Expedition Vehicles, (“Opposer” or “AEV”) filed a Notice of Opposition to registration of Applicant’s mark, alleging likelihood of confusion and dilution by blurring and dilution by tarnishment under Sections 2(d) and 43(c) of the Trademark Act. 15 U.S.C. §§ 1052(d), 1125(c).<sup>2</sup> Opposer claimed ownership of the following design and composite marks, registered on the Principal Register:



for “**Automobiles and structural parts thereof** excluding sports automobiles or exotic cars, parts or accessories for sports automobiles or exotic cars, and any services relating to sports automobiles or exotic cars” in International Class 12.<sup>3</sup> (Emphases added here and hereafter for purposes of comparison with goods identified in Application.)



for the same goods in Class 12: “**Automobiles and structural parts therefor**, excluding sports automobiles or exotic cars, parts or

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<sup>2</sup> 1 TTABVUE.

<sup>3</sup> Reg. No. 3691651, issued October 6, 2009, renewed. Section 8 declarations of use accepted and Section 15 declaration of incontestability acknowledged. According to the description of the mark, “[t]he mark consists of the fanciful design of a bison.” Color is not claimed as a feature of the mark.

accessories for sports automobiles or exotic cars, and any services relating to sports automobiles or exotic cars.”<sup>4</sup>



for “Automobiles and structural parts therefor; **aftermarket structural parts and fittings for land vehicles**; all of the foregoing excluding sports automobiles or exotic cars and parts or accessories for sports automobiles or exotic cars” in International Class 12,

and for

“**Automobile customization services including interior and exterior customization and custom rebuilding of existing land vehicles to construct off-road automobiles and overland expedition automobiles designed for off-road driving**, all of the foregoing excluding any services relating to sports automobiles or exotic cars” in International Class 37.<sup>5</sup>

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<sup>4</sup> Reg. No. 4177842, issued July 24, 2012, Section 8 declaration of use accepted and Section 15 declaration of incontestability acknowledged. According to the description of the mark, “The mark consists of a fanciful design of a bison with the letters ‘AEV’ to the right of the bison. The letters ‘AEV’ and a portion of the bison are surrounded by a parallelogram.” Color is not claimed as a feature of the mark. This mark is also reflected in Reg. No. 5396355, issued February 6, 2018, for stickers, carrying bags, water bottles, and clothing in International Classes 16, 18, 21 and 25, and Reg. No. 5406646, issued Feb. 20, 2018 for paint for automotive structural parts, hand tools, and electronic apparatus and software for programming and calibrating vehicle components in International Classes 2, 8, and 9.

<sup>5</sup> Reg. No. 5269486, issued Aug. 22, 2017. According to the description of the mark, “The mark consists of a fanciful design of a bison with the letters ‘AEV’ in front of and below the head of the bison. A parallelogram is positioned behind the letters ‘AEV’ and the bison, wherein portions of each of the letters ‘AEV’ and a portion of the bison are disposed within the parallelogram interior area.” Color is not claimed as a feature of the mark.



## A M E R I C A N   E X P E D I T I O N   V E H I C L E S

for:

**structural parts for land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, and sport utility vehicles; fittings for land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, and sport utility vehicles,** namely, rail kits for roof racks comprised of planks, crossbars, side rails, end rails, corners, corner closeout plates, corner end rail connectors, brackets, stanchions, and cushion padding for vehicle roof racks, winch mounts, vehicle jack mounts, bumper caps, attachment brackets for vehicle hoods as structural part of vehicles, **wheel well flares**, mud flaps, skid plates, corner guards, **fender flares**, snorkels, **bumpers**, vehicles hoods, tire carriers, cover plates in the nature of winch cover plates, non-winch cover plates for vehicle bumpers, bezels in the nature of vehicle wheel rims, vehicle bumper crush can covers, differential covers, spare tire carriers for vehicles, roof racks, vehicle corner bumper guards, splash guards, mobile storage tanks for fuel storage, mobile storage tanks for coolant storage, mobile tanks for oil storage, mobile storage tanks for water storage, fitted cargo truck bed liners, tonneau covers, tailgates, and wheel protection rings; **interior and exterior accessories for land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, and sport utility vehicles,** namely, rail kits for roof racks comprised of planks, crossbars, side rails, end rails, corners, corner closeout plates, corner end rail connectors, brackets, stanchions, and cushion padding for vehicle roof racks, winch mounts, vehicle jack mounts, bumper caps, attachment brackets for vehicle hoods as structural part of vehicles, **wheel well flares**, mud flaps, skid plates, corner guards, **fender flares**, snorkels, **bumpers**, vehicles hoods, tire carriers, cover plates in the nature of winch cover plates, non-winch cover plates for vehicle bumpers, bezels in the nature of vehicle wheel rims, vehicle bumper crush can covers, differential covers, spare tire carriers for vehicles, roof racks, vehicle corner bumper guards, splash guards, mobile storage tanks for fuel storage, mobile storage tanks for coolant storage, mobile tanks for oil storage, mobile storage tanks for water storage, fitted cargo truck bed liners, tonneau covers, tailgates, and wheel protection rings; **aftermarket interior and exterior accessories for land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, sport utility vehicles,** namely, rail kits for roof racks comprised of planks, crossbars, side rails, end rails, corners, corner closeout plates, corner end rail connectors, brackets, stanchions, and cushion padding for vehicle roof racks, winch mounts, vehicle jack mounts, bumper caps, attachment brackets for vehicle hoods as structural part of vehicles, **wheel well flares**, mud flaps, skid plates, corner guards, **fender flares**, snorkels, **bumpers**, vehicles

hoods, tire carriers, cover plates in the nature of winch cover plates, non-winch cover plates for vehicle bumpers, bezels in the nature of vehicle wheel rims, vehicle bumper crush can covers, differential covers, spare tire carriers for vehicles, roof racks, vehicle corner bumper guards, splash guards, mobile storage tanks for fuel storage, mobile storage tanks for coolant storage, mobile tanks for oil storage, mobile storage tanks for water storage, fitted cargo truck bed liners, tonneau covers, tailgates, and wheel protection rings; **vehicle body kits comprising external structural parts of land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, sport utility vehicles; vehicle conversion kits for making structural changes to land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, sport utility vehicles, comprised of structural parts for land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, sport utility vehicles;** all of the foregoing excluding sports automobiles and exotic cars and parts and accessories for sports automobiles and exotic cars, in International Class 12,<sup>6</sup>

and

**Vehicle customization services for land vehicles; interior and exterior customization and custom rebuilding of existing land vehicles and structural parts therefor;** all of the foregoing excluding any services relating to sports automobiles or exotic cars, in International Class 37.<sup>7</sup>

Applicant, in its Answer, denied the salient allegations of the Notice of Opposition.<sup>8</sup>

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<sup>6</sup> Reg. No. 6102258, issued July 14, 2020. The registration disclaims “EXPEDITION VEHICLES” and claims acquired distinctiveness for “AMERICAN EXPEDITION VEHICLES” under Section 2(f), 15 U.S.C. § 1052(f). According to the description of the mark, “The mark consists of a fanciful design of a bison with the terms ‘AMERICAN EXPEDITION VEHICLES’ positioned to the right of the bison.” Color is not claimed as a feature of the mark.

<sup>7</sup> Reg. No. 6045109, issued May 5, 2020. The registration disclaims “EXPEDITION VEHICLES” and claims acquired distinctiveness for “AMERICAN EXPEDITION VEHICLES” under Section 2(f), 15 U.S.C. § 1052(f). According to the description of the mark, “The mark consists of a fanciful design of a bison with the terms ‘AMERICAN EXPEDITION VEHICLES’ positioned to the right of the bison.” Color is not claimed as a feature of the mark. Opposer also claimed common law rights in its registered marks since at least as early as 1997.

<sup>8</sup> 4 TTABVue. Applicant also pleaded seven “affirmative defenses.” 4 TTABVue 8-9. The first “affirmative defense,” that the Notice of Opposition fails to state a claim upon which relief can be granted, is not an affirmative defense. *TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1101 n. 6 (TTAB 2019). The second through sixth “affirmative defenses” are

We sustain the opposition.

## **I. The Record**

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the subject application. In addition, the parties introduced the following evidence:

### **A. Opposer's Evidence**

- Notice of Reliance on Opposer's pleaded U.S. Trademark Registrations;<sup>9</sup>
- Notice of Reliance on the application file of Opposer's Application Ser. No. 88976022, subsequently registered as Reg. No. 6102258;<sup>10</sup>
- Notice of Reliance on Applicant's Answer and Initial Disclosures;<sup>11</sup>
- Notice of Reliance on media publications about Opposer's goods and services;<sup>12</sup>
- Testimonial declaration of Matthew Feldermann, Opposer's Marketing Manager;<sup>13</sup>

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at best amplifications of Applicant's denials, which we do not consider as separate affirmative defenses. *DeVivo v. Ortiz*, 2020 USPQ2d 10135 at \*1. Applicant's seventh "affirmative defense" alleged nonuse of Opposer's marks: "Opposer is not using its marks for all the goods/services listed within the identification for Opposer's marks, therefore at least some of Opposer's asserted Registrations are invalid." 4 TTABVUE 9. That allegation was not, in fact, an affirmative defense; it should have been brought as a compulsory counterclaim. See Trademark Rules 2.106(b)(3)(i), 2.114(b)(3)(i), 37 C.F.R. §§ 2.106(b)(3)(i) ("A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed."), 2.114(b)(3)(i) (same); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 313.04 (2020). Applicant did not bring a counterclaim or otherwise pursue its claim of nonuse, so we have not considered any of Applicant's arguments in that regard.

<sup>9</sup> 8 TTABVUE.

<sup>10</sup> 9 TTABVUE.

<sup>11</sup> 10 TTABVUE.

<sup>12</sup> 11 TTABVUE.

<sup>13</sup> 12 TTABVUE.

- Testimonial declaration of Michael Messink, Opposer’s Chief Financial Officer;<sup>14</sup> and
- Rebuttal testimonial declaration of Michael Messink.<sup>15</sup>

### **B. Applicant’s Evidence**

- Testimonial declaration of Kenneth Ko, Applicant’s Sales Director, with exhibits;<sup>16</sup> and
- Testimonial declaration of Jay Morris, Director of Vendor Management for AutoAnything, Inc.<sup>17</sup>

## **II. Entitlement to a Statutory Cause of Action**

The statute providing for opposition to registration states that “[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor....” 15 U.S.C. § 1063(a).<sup>18</sup>

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<sup>14</sup> 13 TTABVUE (confidential), 14 TTABVUE (public).

<sup>15</sup> 18 TTABVUE (confidential), 19 TTABVUE (public).

<sup>16</sup> 16-17 TTABVUE.

<sup>17</sup> 15 TTABVUE. Opposer objects to Mr. Morris’s testimony. This objection will be addressed *infra*.

<sup>18</sup> Standing to file an opposition under the statute is now termed entitlement to a statutory cause of action. *Major League Soccer, LLC v. F.C. Int’l Milano S.p.A.*, 2020 USPQ2d 11488, at \*5 n. 18 (TTAB 2020). Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain equally applicable. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \*4 (Fed. Cir. 2020). As the Court of Appeals for the Federal Circuit has observed, there is “no meaningful, substantive difference between the analytical frameworks” in the prior “standing” case law, under which a plaintiff must show a real interest in the proceeding and a reasonable basis for its belief in damage, *see Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d

Under the statute, “[a] claim of likelihood of confusion that is not wholly without merit, including prior use of a confusingly similar mark, may be sufficient ‘to establish a reasonable basis for a belief that one is damaged.’” *DeVivo v. Ortiz*, 2020 USPQ2d 10153 at \*2 (internal punctuation omitted).

Opposer’s pleaded registrations, consisting of or containing its bison logo, establish its entitlement to oppose registration of Applicant’s mark. The record shows that these registrations are valid and subsisting.<sup>19</sup> *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Primrose Ret. Comm’s., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1032 (TTAB 2016). Once an opposer meets the requirements for entitlement on one claim, it can rely on any other available statutory grounds for opposition set forth in the Trademark Act, including dilution under 15 U.S.C. § 1125(c). *See generally AT&T Mobility LLC v. Thomann and Dormitus Brands LLC*, 2020 USPQ2d 53785, \*5-6 (TTAB 2020).

Applicant does not contest Opposer’s statutory entitlement to oppose its application.

### III. Likelihood of Confusion

To prevail on the ground of likelihood of confusion under Section 2(d), Opposer must prove priority and likelihood of confusion by a preponderance of the evidence.

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1058, 1062 (Fed. Cir. 2014), and the current “entitlement” case law, under which a plaintiff must show an interest falling within the zone of interests protected by statute and damage proximately caused by registration. *Corcamore v. SFM*, 2020 USPQ2d 11277 at \*4.

<sup>19</sup> Notice of Opposition, ex. A, 1 TTABVUE 26-39; Notice of Reliance on Opposer’s pleaded U.S. Trademark Registrations, 8 TTABVUE.

*Cunningham v. Laser Golf*, 55 USPQ2d at 1848.

**A. Priority**

An opposer may establish its prior proprietary rights in a trademark through its ownership of a registration, among other means. *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (Fed. Cir. 1981). Opposer has established that it owns registered marks consisting of or containing its bison logo, and there is no pending counterclaim to cancel the registrations, so priority is not an issue with respect to the marks, goods and services identified in the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Applicant does not contest Opposer's priority.

**B. The *DuPont* Factors**

Section 2(d) of the Trademark Act provides that an applied-for mark may be refused registration if it “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive....” 15 U.S.C. § 1052(d).

To determine whether there is a likelihood of confusion between the parties' respective marks under Section 2(d), we analyze the evidence and arguments under the *DuPont* factors. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). We consider each relevant *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d

1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. ... Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, \*3 (Fed. Cir. 2020). “In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services.” *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004), *cited in Ricardo Media v. Inventive Software*, 2019 USPQ2d 311355 at \*5 (TTAB 2019).

### **1. The Goods and Services**

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014).

Applicant’s identified goods, again, are:

land vehicle parts, namely, fender flares, bumpers,  
running boards, side step bar, bull bars, light guards.

Opposer’s pertinent goods and services, bolded above, are:

**Automobiles and structural parts thereof (or therefor);<sup>20</sup>**

**Aftermarket structural parts and fittings for land vehicles;**

**Automobile customization services including interior and exterior customization and custom rebuilding of existing land vehicles to construct off-road automobiles and overland expedition automobiles designed for off-road driving;<sup>21</sup>**

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<sup>20</sup> Reg. Nos. 3691651 and 4177842.

<sup>21</sup> Reg. No. 5269486.

Structural parts for land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, and sport utility vehicles; fittings for land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, and sport utility vehicles, namely, ... fender flares, bumpers;

Interior and exterior accessories for land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, and sport utility vehicles, namely... fender flares, bumpers;

Aftermarket interior and exterior accessories for land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, sport utility vehicles, namely, ... fender flares, bumpers;

Vehicle body kits comprising external structural parts of land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, sport utility vehicles;

Vehicle conversion kits for making structural changes to land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, sport utility vehicles, comprised of structural parts for land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, sport utility vehicles;<sup>22</sup>

Vehicle customization services for land vehicles; interior and exterior customization and custom rebuilding of existing land vehicles and structural parts therefor....<sup>23</sup>

All of the foregoing identifications of Opposer's goods and services exclude sports automobiles and exotic cars and parts and accessories for sports automobiles and exotic cars.

Applicant argues that "Opposer makes much of the fact that the descriptions of goods and services in the applications to register Opposer's Marks and K2's Mark have some overlap."<sup>24</sup> Nevertheless, it contends, "[t]wo entities offering goods and services within a sweeping category such as automotive parts does not compel a

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<sup>22</sup> Reg. No. 6102258.

<sup>23</sup> Reg. No. 6045109.

<sup>24</sup> Applicant's brief, 23 TTABVUE 22.

finding that the goods are related. ... While Opposer and K2 both market and sell products within the automotive industry, their goods and services are not identical, especially given the broad and vague definition of goods and services described in the applications for Opposer's Marks."<sup>25</sup>

Applicant's argument, however, pertains where goods and services in a common industry or field are clearly disparate. *See Borg-Warner Chem., Inc. v. Helena Chem. Co.*, 225 USPQ 222, 224 (TTAB 1983) ("The Board in the past has found no likelihood of confusion even with respect to identical marks applied to goods and/or services used in a common industry where such goods and/or services are clearly different from each other and there is insufficient evidence to establish a reasonable basis for assuming that the respective goods as identified by their marks, would be encountered by the same purchasers.").

In this case, however, the parties' goods are identical in part and otherwise legally identical, notwithstanding the exclusion of sports and exotic cars and parts therefor in Opposer's identifications. Both identify "bumpers," like this:



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<sup>25</sup> *Id.*

<sup>26</sup> Matthew Feldermann declaration, ex. A, 12 TTABVUE 75.

and “fender flares,” which look like this:



The parties' goods are thus identical in part. “[T]he fact that even some of applicant’s goods are identical to opposer’s goods means the similarity of the goods factor favors opposer.” *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1507 (TTAB 2007). See also *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, \*6 (TTAB 2019) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA (1981)) (relatedness of any goods in a class supports a finding of relatedness for that entire class).

Moreover, all of Applicant’s goods fall well within the scope of Opposer’s identified goods: “automobiles and structural parts thereof (or therefor),” “aftermarket structural parts and fittings for land vehicles,” “vehicle body kits comprising external structural parts of land vehicles,” and “vehicle conversion kits for making structural changes to land vehicles.” Because Opposer’s identified goods, despite the exclusionary language, remain sufficiently broad to encompass Applicant’s more

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<sup>27</sup> Feldermann decl. ex. A, 12 TTABVUE 71.

narrowly identified goods, they are legally identical. *See Double Coin v. Tru*, 2019 USPQ2d 377409 at \*6 (“the ‘tires’ identified in Tru’s registration encompass, and thus are legally identical to, at least the ‘vehicle wheel tires,’ ‘automobile tires,’ and ‘tires for vehicle wheels’ identified in Double Coin’s registration.”) (citing *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture’”)).

Beyond that, even with the restriction, Opposer’s identified services provide the very sorts of structural parts Applicant identifies: “vehicle customization services for land vehicles; interior and exterior customization and custom rebuilding of existing land vehicles and structural parts therefor...” and “automobile customization services including interior and exterior customization and custom rebuilding of existing land vehicles to construct off-road automobiles and overland expedition automobiles designed for off-road driving.” The parties’ goods and services are thus related. *See, e.g., In re Detroit Ath. Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (“Indeed, we have held that confusion is likely where one party engages in retail services that sell goods of the type produced by the other party, as here.”) *quoted in In re Country Oven, Inc.*, 2019 USPQ2d 443903, \*13 (TTAB 2019).

In sum, the parties’ goods and services are identical in part, legally identical, and otherwise related. The second *DuPont* factor thus weighs heavily in favor of a likelihood of confusion.

## 2. The Channels of Trade

The third *DuPont* factor concerns “[t]he similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567.

Because the parties’ goods are identical in part and legally identical, they are presumed to flow through the same channels of trade to the same classes of customers—here, motorists seeking customized structural modifications for their vehicles.<sup>28</sup> See *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (identical goods) cited in *Zheng Cai v. Diamond Hong*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (legally identical goods).

Applicant attempts to negate this presumption by arguing that “the parties cater to different segments of the automotive aftermarket market. K2’s Mark is used to market automotive parts for vehicles of all makes, models, and sizes to consumers. In contrast, Opposer’s goods and services cater specifically to Jeep owners and other off-road enthusiasts.”<sup>29</sup> In this vein, Applicant adduces the testimony of Jay Morris, Director of Vendor Management for AutoAnything, Inc., “one of the largest and most popular online retailers of specialized aftermarket automotive products.”<sup>30</sup> He testifies that:

Within the AutoAnything family of online automotive aftermarket part distributors, K2 and AEV do not exist within the same trade channel.

K2’s Bulken brand products appear exclusively on the AutoAnything.com website, whereas the AEV products appear exclusively on AutoAnything’s

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<sup>28</sup> See Feldermann decl. ¶ 25, 12 TTABVUE 12.

<sup>29</sup> Applicant’s brief, 23 TTABVUE 22.

<sup>30</sup> Morris decl. ¶ 5-6, 15 TTABVUE 3.

more specialized Morris 4x4 Center online platform. AutoAnything.com provides consumers with automotive parts for vehicles of all makes, models, and sizes, whereas the Morris 4x4 Center online platform caters specifically to Jeep owners and other off-road enthusiasts.<sup>31</sup>

But Opposer's identified goods and services, despite the restrictive language, are not limited to off-road vehicles or their enthusiasts. Although one of its registrations recites "automobile customization services including interior and exterior customization and custom rebuilding of existing land vehicles to construct off-road automobiles and overland expedition automobiles designed for off-road driving...,"<sup>32</sup> the rest of its registrations more broadly identify:

- "automobiles and structural parts thereof" (or "therefor");<sup>33</sup>
- "aftermarket structural parts and fittings for land vehicles";<sup>34</sup>
- "structural parts for land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, and sport utility vehicles; fittings for land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, and sport utility vehicles";

"interior and exterior accessories for land vehicles, automobiles, passenger

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<sup>31</sup> Morris decl. ¶¶ 17-18, 15 TTABVUE 6. Opposer, having received correspondence from AutoAnything's outside counsel, objects that Mr. Morris does not speak on behalf of AutoAnything. See Opposer's confidential brief, 20 TTABVUE 13, 55-57, Opposer's confidential reply brief, 24 TTABVUE 8. Applicant responds that "Regardless of whether he speaks for his employer rather than in a personal capacity, Mr. Morris provides relevant evidence from an experienced source." Applicant's confidential brief, 22 TTABVUE 10. Since the correspondence from outside counsel does not constitute admissible testimony, Applicant asks that we either strike it or give its contents no weight. 22 TTABVUE 12. We understand that Mr. Morris testifies solely on his own behalf, based on his personal observations, and does not speak on behalf of his employer. Like any testimony, we accord his testimony whatever probative value it deserves, bearing in mind any inherent limitations. *Ricardo Media v. Inventive Software*, 2019 USPQ2d 311355 at \*3. We disregard any opinions he may express on the ultimate issues in the case. See *Double Coin v. Tru*, 2019 USPQ2d 377409 at \*3-4. Since the correspondence from AutoAnything's outside counsel does not constitute admissible testimony, we give it no weight.

<sup>32</sup> Reg. No. 5269486.

<sup>33</sup> Reg. Nos. 3691651 and 4177842.

<sup>34</sup> Reg. No. 5269486.

pick-up trucks, light-duty pick-up trucks, and sport utility vehicles”;

“vehicle body kits comprising external structural parts of land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, sport utility vehicles; vehicle conversion kits for making structural changes to land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, sport utility vehicles, comprised of structural parts for land vehicles, automobiles, passenger pick-up trucks, light-duty pick-up trucks, sport utility vehicles”; and

“Vehicle customization services for land vehicles; interior and exterior customization and custom rebuilding of existing land vehicles and structural parts therefor....”<sup>35</sup>

Like the second factor, the third factor “must be evaluated with an eye toward the channels specified in the application and registration, not those as they exist in the real world.” *In re Detroit Ath.*, 128 USPQ2d at 1052 (citing *i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)). Applications and registrations with no restriction on trade channels cannot be narrowed by testimony that their use is, in fact, restricted to a particular class of purchasers. *Id.*; see also *Stone Lion v. Lion Capital*, 110 USPQ2d at 1162. Here, the application and registrations are, for the most part, unrestricted, and their overlapping, legally identical goods would tend to travel through the same channels to the same sorts of motorists—those seeking customized structural modifications for their vehicles. As Applicant’s Sales Director, Kenneth Ko, testified, the parties “were both advertising off-road parts and accessories” at the same trade show.<sup>36</sup>

Even if the parties’ goods appear on “sister”<sup>37</sup> websites in the AutoAnything

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<sup>35</sup> Reg. No. 6045109.

<sup>36</sup> Ko decl. ¶ 35, 16 TTABVUE 10. See also Messink rebuttal decl. ¶ 13, 19 TTABVUE 7-8.

<sup>37</sup> Applicant’s brief, 23 TTABVUE 23-24.

“family” of online automotive aftermarket platforms,<sup>38</sup> that does not evince a meaningful divergence in channels of trade. Channels of trade include “the same type of distribution channel” and are not limited to “identical stores or agents.” *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992). To the extent there is any divergence, Opposer, the owner of registrations identifying parts for on-road as well as off-road vehicles, could offer some of its goods on the AutoAnything.com website. *See In re Detroit Ath.*, 128 USPQ2d at 1052 (“Indeed, the owner of an unrestricted registration is entitled to change its current trade channels at any time.”). And Applicant, which offers parts for off-road vehicles, among other types of vehicles, could offer some of its goods on the Morris 4x4 Center online platform. *See B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1507 (TTAB 2007) (“However, because the parties do not limit the channels of trade in their respective identifications, we must assume that they could use the same channels of trade for these legally identical goods even if they are not now doing so.”).

Applicant thus fails to negate the presumption that the parties’ goods and services share the same channels of trade and class of customers, and the third *DuPont* factor weighs heavily in favor of a likelihood of confusion.

### **3. The Marks**

Under the first *DuPont* factor, we consider the similarity or dissimilarity of Opposer’s and Applicant’s marks “in their entirety as to appearance, sound, connotation and commercial impression.” *DuPont*, 177 USPQ at 567; *In re Detroit*

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<sup>38</sup> Morris decl. ¶¶ 17-18, 15 TTABVUE 6.

*Ath.*, 128 USPQ2d at 1048. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

Because the parties’ identified goods are in part identical and otherwise legally identical, the degree of similarity needed to support a conclusion of likely confusion declines. *Zheng Cai v. Diamond Hong*, 127 USPQ2d at 1801; *In re Viterra*, 101 USPQ2d at 1908; *Bridgestone Ams. Tire Ops. LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012).

Applicant’s mark, again, is  , and Opposer’s marks, once again, are:



We focus first on the design mark in Registration No. 3691651 for legally identical goods, because if we do not find a likelihood of confusion with respect to this mark, then there would be no likelihood of confusion with the marks in the other cited registrations.

Applicant K2 asserts that “the marks share more differences than similarities.”<sup>39</sup> Specifically, its Sales Director notes:

12. When I look at the details of the Bulken Mark and the AEV Mark above as they appear side by side, I observe that:
  - a. The Bulken Mark is a stylized artistic representation of both a bull and a mountain, whereas the AEV Mark is a shaded drawing of a bison.
  - b. The two marks are not depicting the same species of animal, the Bulken Mark depicts a bull, and the AEV Mark depicts a bison.
  - c. The Bulken Mark is an intentionally two-dimensional piece of artwork, whereas the AEV Mark is shaded and gives me the impact of a three-dimensional bison in shape and depth.
  - d. The Bulken Mark takes artistic liberties in the depiction of the bull, such as the omission of hooves, whereas the AEV Mark depicts the bison with almost every aspect present, including hooves, fur, nose details, muscular shading, eye and brow detail, and the suggestion of a light source radiating onto the bison.
  - e. The Bulken Mark is a dual symbol in that it depicts both a bull and a mountain, whereas the AEV Mark depicts solely a bison.
  - f. The Bulken Mark’s distinctive mountain shape comes up to a point at the top of the mark, whereas the AEV Mark depicts a bison whose back is rounded at the top.

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<sup>39</sup> Applicant’s brief, 23 TTABVUE 18.

- g. The Bulken Mark depicts a mountain like bull charging to the left, whereas the AEV Mark depicts a bison in ready to charge, but stationary posture, and facing to the right.
- h. The Bulken Mark depicts a bull with horns pointing forward, whereas the AEV Mark depicts a bison with horns pointing towards its back.
- i. The Bulken Mark depicts a bull with a distinct tail that is detached from the bull, whereas the AEV mark depicts a bison whose tail is harder to distinguish, and is visually attached to the bison on both ends.<sup>40</sup>

Under actual marketing conditions, however, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, as Applicant's Sales Director has done. *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980). They do not tend to scrutinize marks' details, *In re Information Builders Inc.*, 2020 USPQ2d 10444, \*6 (TTAB 2020), and must rely upon their imperfect recollections thereof. *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016). "[M]ore frequently than not, such recollection is not enhanced with minute details or specific characteristics of the marks, but is determined by an overall or general impression of the many and various marks that exist in the marketplace." *In re Info. Builders*, 2020 USPQ2d 10444 at \*6-7.

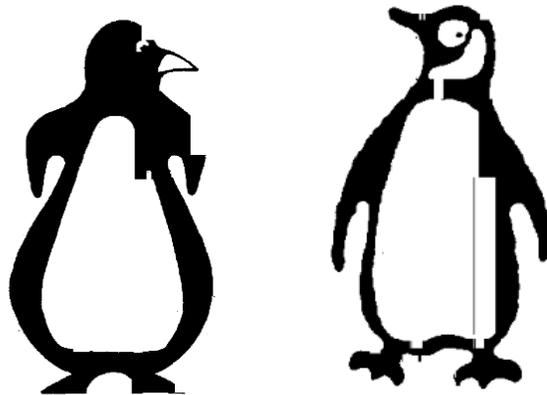
Viewed from that perspective, the relevant consumers—motorists seeking customized structural modifications for their vehicles—are likely to perceive the parties' marks as more similar than dissimilar. Both designs depict bovine figures:

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<sup>40</sup> Ko decl. ¶ 12, 16 TTABVUE 5-6; Applicant's brief, 23 TTABVUE 7-8, 19.



The bovine subfamily includes cattle and bison.<sup>41</sup> Both designs depict bulls.<sup>42</sup> Both bulls appear in a three-quarter perspective, their feet planted, their heads lowered beneath prominent humps, as if threatening to charge. Although one faces left and one faces right, that distinction would be little noted nor long remembered—as demonstrated by analogous cases:



*Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (“[W]e believe there is a striking similarity between opposer’s registered design mark for books and applicant’s mark.”).

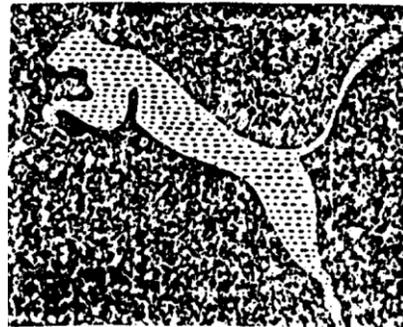
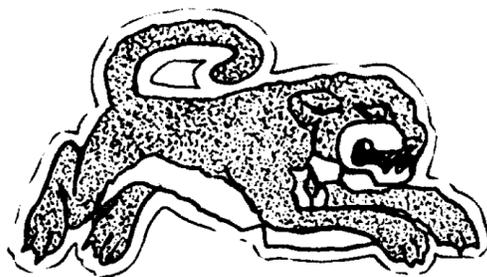
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<sup>41</sup> “Bovine,” Merriam-Webster.com, Dictionary.com, accessed 4/2/21. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010).

<sup>42</sup> “Bull,” “the male of a bovine animal, especially of the genus *Bos*, with sexual organs intact and capable of reproduction.” Dictionary.com, accessed 4/2/21.



*Time Warner Ent. Co. L.P. v. Jones*, 65 USPQ2d 1650, 1660 (TTAB 2002) (both marks consist of a “fanciful cartoon depiction of a roadrunner bird. In terms of the marks’ overall commercial impressions, these basic similarities outweigh any specific dissimilarities that might be apparent upon side-by-side comparison of the marks, whether those dissimilarities are considered alone or in combination.”)



*Puma-Sportschuhfabriken Rudolf Dassler KG v. Garan, Inc.*, 224 USPQ 1064, 1066 (TTAB 1984) (“While specific differences might be noted in a side-by-side comparison of applicant’s and opposer’s leaping, running, feline animals, this fact is not determinative.” ... “[R]epresentations of large, wild, feline animals in what appear to be running, leaping or stalking poses evoke commercial impressions similar to those produced by opposer’s design marks....”).

Here, as in those cases, our determination is based not on the direction the bulls face, nor on minute details of their backs, horns, or tails; it is based on the design

marks in their entireties. *In re Detroit Ath.*, 128 USPQ2d at 1048. Even though Applicant's design is more stylized than Opposer's design, the two designs, taken as a whole, evoke a substantially similar commercial impression.

As the Board has declared:

There is no doubt but that if the design marks here involved would be placed side-by-side certain differences between them including those enumerated by applicant would be discernible. But in the normal environment of the marketplace where purchases are actually made, individuals would not usually have an opportunity to examine these marks in minute detail. An individual relies on his recollection of the marks that he has previously encountered in the marketplace. And, more often than not, in the case of design marks, his recollection is not obfuscated with minute details or characteristics of the marks, but is governed by an overall or general impression of the many marks that surround him in his daily living experiences. Viewing the marks in question in this light, it is apparent that there are marked resemblances in overall design format, and commercial impression. These resemblances are sufficient, in and of themselves, to cause individuals, including those described by applicant as discriminating, familiar with either mark and then encountering the other on competitive goods, to mistakenly believe that these products originate from the same producer.

*In re Steury Corp.*, 189 USPQ 353, 355 (TTAB 1975).

Applicant contends that "Opposer has presented no evidence to suggest that consumers recognize Opposer's bison, standing alone, as a mark associated with Opposer," citing *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135 (Fed. Cir. 2015) *cert. denied*, 577 U.S. 1119, 136 S. Ct. 982 (2016).<sup>43</sup>

But in *Jack Wolfskin*, the opposer's mark was  , its literal portion preceding and dwarfing its paw design. As the Court of Appeals for the

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<sup>43</sup> *Id.*

Federal Circuit found in that case, “the KELME element of its registered mark is the dominant portion of the mark.” *Id.* at 1136-37. “None of the examples in the record, however, conclusively establishes that the paw print alone was used for source identification.” *Id.* at 1135. For that reason, among others, the Federal Circuit found that there was no likelihood of confusion between that mark and the applicant’s

mark,  . *Id.* at 1137.

In this case, however, Opposer’s bison design logo, standing alone, is a registered

mark: .<sup>44</sup> As such, it is entitled to the presumption of validity accorded all registered marks under Section 7(b) of the Trademark Act. 15 U.S.C. § 1057(b). *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1889 (TTAB 2006).

Consumers could easily perceive Applicant’s design mark as a stylistically modified version of Opposer’s design mark. *Cf. Jack Wolfskin*, 116 USPQ2d at 1133-34 (new, stylistically altered version of opposer’s mark,

**KELME** , created the same continuing commercial impression as its original mark **KELME**  ). And since the parties’ marks appear on identical or legally identical auto body parts, consumers who encounter the marks in the marketplace would be likely to assume that they have a common source. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101

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<sup>44</sup> Reg. No. 3691651.

USPQ2d 1713, 1721 (Fed. Cir. 2012). On the whole, then, the parties' design marks are more similar than dissimilar.

Despite the similar bovine designs, Applicant argues that the literal elements in Opposer's composite marks, AEV and AMERICAN EXPEDITION VEHICLES, "definitively render the marks so distinct there is no possibility they are confusingly similar."<sup>45</sup> We find, however, that the similar bovine designs render the parties' marks more similar than dissimilar. As we have found, Opposer's bovine design is inherently distinctive. That design is similar to Applicant's design mark, which has no other elements to distinguish it from Opposer's marks. Applicant's design mark could easily be perceived as a stylistically modified version of Opposer's design. And it appears on identical or legally identical automobile body products, all of which are offered to the same class of customers.

Consequently, Applicant's mark is similar to Opposer's design and composite marks, and the first *DuPont* factor weighs in favor of a likelihood of confusion.

#### **4. Consumer Sophistication and Care**

Under the fourth *DuPont* factor, we consider "[t]he conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing." *DuPont*, 177 USPQ at 567.

Applicant states that "due to the nature of the goods sold by both parties, the customers of both Opposer and K2 are sophisticated and are unlikely to be shopping on an impulse basis. ... The customers exercise great care in their selection of a product and are typically seeking to purchase a specific product or package for their

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<sup>45</sup> Applicant's brief, 23 TTABVUE 20.

particular vehicle from their preferred brand because failure to do so will lead to a lack of fitment.”<sup>46</sup>

Motorists seeking customized structural modifications for their vehicles could come from all walks of life, and are not necessarily sophisticated. *Cf. Speedbar, Inc. v. JEC Dev., Inc.*, 76 USPQ2d 1034, 1040 (TTAB 2005) (finding purchasers of auto repair services are “ordinary consumers who are not necessarily sophisticated.”). But the cost of making discretionary structural modifications to base models of vehicles would naturally impel them to exercise care in selecting those parts. *See In re Info. Builders Inc.*, 2020 USPQ2d 10444, at \*4 (“[I]n light of the inherent nature of the goods and services involved, some degree of purchasing care may be exercised by Applicant’s potential or actual consumers.”).

Even though the relevant class of buyers may exercise care in selecting auto body modifications, that “does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods [or services]. ‘Human memories even of discriminating purchasers . . . are not infallible.’” *In re Research & Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (quoting *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970)) *quoted in In re Info. Builders Inc.*, 2020 USPQ2d 10444 at \*4. Given the similarity of the marks, as well as the overlap in the goods and trade channels, we are not convinced that even careful purchasers would avoid confusion. *See Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1063 (TTAB 2017) (citing *Weiss Assocs. v. HRL Assocs.*, 902 F.2d 1546, 14 USPQ2d 1840, 1841-42 (Fed.

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<sup>46</sup> Applicant’s brief, 23 TTABVUE 24; *see also* Morris decl. ¶ 19, 15 TTABVUE 7.

Cir. 1990)). Given those similarities, “even careful purchasers who do notice the difference in the marks will not ascribe it to differences in the source of the goods, but will see the marks as variations of each other, pointing to a single source.” *In re I-Coat*, 126 USPQ2d at 1739.

Consequently, the fourth *DuPont* factor weighs slightly against a likelihood of confusion.

### **5. The Strength of Opposer’s Marks**

The fifth *DuPont* factor is “[t]he fame of the prior mark (sales, advertising, length of use).” *DuPont*, 177 USPQ at 567.

The strength of a mark is not “an all-or-nothing measure” in the context of likelihood of confusion. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017). Rather, it “varies along a spectrum from very strong to very weak.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015) (internal citations omitted). “A very strong mark receives a wider latitude of legal protection in the likelihood of confusion analysis,” *Tao v. Bender*, 125 USPQ2d at 1056, while a very weak mark receives a narrower scope of protection. A mark in the middle of the spectrum receives an intermediate scope of protection. *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017) (finding opposer’s marks entitled to “the normal scope of protection to which inherently distinctive marks are entitled”).

In determining strength of a mark, we consider both conceptual strength, based on the nature of the mark itself, and commercial strength, based on marketplace

recognition. See *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength.”). J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. March 2021 update) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”).

In determining the conceptual strength of each of Opposer’s marks, “we evaluate its intrinsic nature, that is, where it lies along the generic-descriptive-suggestive-arbitrary (or fanciful) continuum....” *In re Davia*, 110 USPQ2d at 1815. Three of Opposer’s marks are registered on the Principal Register without a showing of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f):



So they are presumed to be inherently distinctive. *New Era Cap Co. v. Pro Era LLC*, 2020 USPQ2d 10596, \*10 (TTAB 2020) (“Opposer’s mark is inherently distinctive as evidenced by its registration on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act.”); *Tea Board of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1889 (TTAB 2006) (same).

As noted, Opposer’s fourth registered mark,



, disclaims

“EXPEDITION VEHICLES” and claims that “AMERICAN EXPEDITION VEHICLES” has acquired distinctiveness under Section 2(f), conceding that the mark’s wording is not inherently distinctive. *Cold War Museum v. Cold War Air Museum*, 92 USPQ2d at 1629. Still, the bison design element is considered inherently distinctive in all four marks. We discuss the conceptual weakness of the bison design as shown by third-party registrations below.

The commercial strength or fame of a mark rests on the extent to which “a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator.” *Joseph Phelps Vineyards v. Fairmont Holdings*, 122 USPQ2d at 1734 (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). Commercial strength or fame may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods or services sold under the mark, and supported by other indicia such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods or services identified by the marks; and the general reputation of the goods or services. *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014), *appeal dismissed per stipulation*, No. 2014-1461 (Fed. Cir. Oct. 10, 2014); *see also Bose*, 63 USPQ2d at 1308 (recognizing indirect evidence as appropriate proof of strength). “[T]he proper legal standard for evaluating the fame of a mark under the fifth *DuPont*

factor is the class of customers and potential customers of a product or service, and not the general public.” *Joseph Phelps Vineyards*, 122 USPQ2d at 1734.

Opposer introduced the following evidence of its marks’ commercial strength:

- Opposer has been using the registered marks on or in connection with automobiles and structural parts thereof continually since at least as early June 2009.<sup>47</sup>
- Since 2009, Opposer has made sales of structural parts and fittings for land vehicles, and “turn-key” sales of sports utility vehicles and pickup trucks under the marks in the millions of dollars. The precise numbers are confidential but substantial.<sup>48</sup>
- Opposer has also expended a confidential but substantial annual amount on advertising under the marks.<sup>49</sup>
- Opposer advertises its structural parts and fittings, as well as its custom turn-key land vehicles, through its website, AEV-Conversions.com, which



prominently displays the  mark at the top of every page. The website typically generates more than 150,000 hits each month, and has accrued more than 25,000,000 total hits since the year 2000.<sup>50</sup>

- Opposer uses social media to promote and advertise its structural parts and fittings for land vehicles, as well as custom turn-key vehicles. Its Facebook page was created in 2012 and has more than 56,000 followers. Its Instagram page was created in 2013 and has more than 111,000 followers. Its Twitter page was created in 2012 and has more than 4,200 followers. And its YouTube channel was created in 2006 and has over 12,700 subscribers.<sup>51</sup>
- Opposer has received unsolicited media coverage and attention in print publications such as *Popular Mechanics*, *Car and Driver*, *Forbes*, *Motor Trend*,

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<sup>47</sup> Messink decl. ¶¶ 11, 13-14, 17, 14 TTABVUE 5-8. Feldermann decl. ¶ 9, 12 TTABVUE 5.

<sup>48</sup> Messink decl. ¶¶ 20-21, 13 TTABVUE 8-9, Messink rebuttal decl. ¶ 10, 18 TTABVUE 6 (confidential).

<sup>49</sup> Messink decl. ¶ 22, 13 TTABVUE 9 (confidential).

<sup>50</sup> Feldermann decl. ¶ 14, 12 TTABVUE 7, Messink decl. ¶ 23, 14 TTABVUE 9.

<sup>51</sup> Feldermann decl. ¶ 15, 12 TTABVUE 7-8; Messink decl. ¶ 24, 14 TTABVUE 9-10.

and *the New York Times*; and in the television programs *TopGear USA* and *The Bachelor*.<sup>52</sup>

- Opposer advertises its goods and services by sponsoring events and athletes. For example, it sponsored Team Lerner Reina, which won the Australasian Safari endurance motorsport race in a modified Wrangler bearing the marks.<sup>53</sup>
- Opposer has received at least eight industry awards over the past 23 years, including garnering repeated recognition at the SEMA trade show, and recognition of the 2020 Overland Truck of the Year.<sup>54</sup>

Applicant counters that “[w]hile Opposer has submitted evidence suggesting it may be a healthy commercial business, its annual sales figures and marketing expenditures fall far short of the indicia of fame that Opposer claims.”<sup>55</sup> It argues that “Opposer offers no evidence, such as consumer surveys, of actual recognition of its marks.”<sup>56</sup> But a survey is not a requirement; as noted, strength may be measured indirectly. *Tao v. Bender*, 125 USPQ2d at 1056 (citing *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1308 (Fed. Cir. 2002) (recognizing indirect evidence as appropriate proof of strength)).

Applicant then questions the sufficiency of Opposer’s indirect evidence, arguing that Opposer’s three dozen or so appearances in media outlets do not suggest it has a famous mark, even in a niche market.<sup>57</sup> Opposer counters that it has submitted a representative sample of media coverage, rather than an exhaustive listing, as that

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<sup>52</sup> Opposer’s notice of reliance, 11 TTABVUE; Feldermann decl. ¶¶ 16-17, 12 TTABVUE 8-9; Messink decl. ¶¶ 25-26, 14 TTABVUE 10-12.

<sup>53</sup> Opposer’s notice of reliance, 11 TTABVUE 6; Feldermann decl. ¶ 18, 12 TTABVUE 9; Messink decl. ¶ 27, 14 TTABVUE 12.

<sup>54</sup> Messink decl. ¶ 28, 14 TTABVUE 12-13; Opposer’s brief, 21 TTABVUE 26, 38.

<sup>55</sup> Applicant’s brief, 23 TTABVUE 8.

<sup>56</sup> Applicant’s brief, 23 TTABVUE 8.

<sup>57</sup> Applicant’s brief, 23 TTABVUE 8.

would constitute cumulative evidence.<sup>58</sup> We find that the evidence submitted, including articles from motorist-oriented publications such as *Car and Driver*, and *AutoWeek* on the one hand, and general interest publications such as *The New York Times* and *Forbes*, suffices to establish Opposer’s brand recognition in media outlets.

Applicant argues, however, that this media attention, and Opposer’s own use of its marks, reveal that it rarely, if ever uses its bison design mark standing alone, without “AEV” or “AMERICAN EXPEDITION VEHICLES.”<sup>59</sup> Applicant draws parallels between this case and a nonprecedential Board decision, *Blue Nile, Inc. v. Brent Neale LLC*, Opp. 91239053, 2020 WL 2302386 (TTAB 2020), which found that that opposer failed to prove that its cited registered mark, BN (stylized), was commercially strong for jewelry because it almost invariably used the stylized BN in conjunction with its trade name, Blue Nile.<sup>60</sup>

We find, though, that the *Blue Nile* case is distinguishable from this case. In *Blue*

*Nile*, both parties had stylized “BN” letter marks,  for opposer Blue Nile, Inc.

and  for applicant Brent Neale LLC. Blue Nile claimed that its stylized letters “BN” had become famous for jewelry. The Board found, though, that:

With the exception of the displaying the marks at issue on jewelry, neither party displays the marks at issue as a standalone mark; the parties use their respective stylized BN marks in conjunction with their Blue Nile and Brent Neale trade names. Thus, when consumers are shopping for jewelry,

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<sup>58</sup> Opposer’s reply brief, 25 TTABVUE 10.

<sup>59</sup> Morris decl. ¶ 15, 15 TTABVUE 6, Ko decl. ¶ 38, 16 TTABVUE 11.

<sup>60</sup> Applicant’s brief, 23 TTABVUE 17.

the parties are promoting the trade names Blue Nile and Brent Neale, and, to a lesser extent rather, the stylized BN trademarks.<sup>61</sup>

The persuasiveness of Opposer's evidence [of commercial strength] is dramatically reduced because, with the exception of the stylized BN mark appearing on the jewelry itself, every example of Opposer's use of the stylized BN mark includes Opposer's trade name, Blue Nile.<sup>62</sup>

Viewing Opposer's evidence as a whole and in its entirety, not only has Opposer failed to meet its burden of proving that its stylized BN mark is famous, Opposer has failed to prove that its stylized BN mark is commercially strong.<sup>63</sup>

The Board held that, "Based on the foregoing, we find that Opposer's stylized BN mark lies in the middle of the spectrum from very strong to very weak. Nevertheless, Opposer's stylized BN mark is entitled to the broad scope of protection normally accorded an arbitrary mark."<sup>64</sup>

Here, Opposer relies not only on its registered design mark, which displays the bison standing alone, but also on its registered composite marks, each of which prominently displays the bison at the forefront of each mark. The bison is the only inherently distinctive part of the  AMERICAN EXPEDITION VEHICLES mark, and stands as the lead element of the other composite marks, trailed by the nondescript letters "AEV." Thus whenever Opposer's marks are displayed, the purchasing public's gaze would fall first on the more prominent feature: its bison design.

Moreover, as Opposer points out, each of the media mentions contains a photo or

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<sup>61</sup> *Blue Nile, Inc. v. Brent Neale LLC*, 2020 WL 2302386 at \*7.

<sup>62</sup> *Id.* at \*10.

<sup>63</sup> *Id.*

<sup>64</sup> *Id.*

video displaying its marks with the bison design. And each of its website pages is

topped with the  mark.<sup>65</sup>

So unlike *Blue Nile*, where the opposer's trade name eclipsed its stylized letter mark, Opposer's bison design is a prominently displayed, distinctive element in all of its marks.

We find, based on the entirety of the evidence, that Opposer's registered marks, consisting of or comprising its bison design, are not commercially "famous," but have achieved a sizeable amount of exposure among motorists seeking customized structural modifications for their vehicles. Opposer's pleaded marks are thus somewhat commercially strong, and entitled to a concomitantly broader scope of protection. *See Joseph Phelps Vineyards*, 122 USPQ2d at 1734-35.

## **6. Similar Marks on Similar Goods**

The sixth *DuPont* factor considers "[t]he number and nature of similar marks in use on similar goods." *DuPont*, 177 USPQ at 567. "Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imps., Inc. v. Veuve Clicquot*, 73 USPQ2d at 1693, *quoted in Jack Wolfskin*, 116 USPQ2d at 1136.

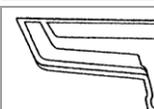
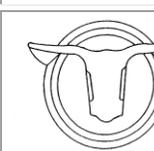
Applicant seeks to attenuate the strength of Opposer's marks by citing nearly three dozen third-party registrations that use some version of a bull or a bison in their marks to promote goods or services in the automotive industry.<sup>66</sup>

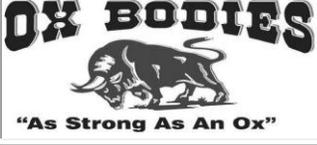
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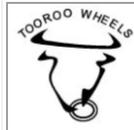
<sup>65</sup> Opposer's reply brief, 25 TTABVUE 15.

<sup>66</sup> Ko decl. ¶¶ 26-27, 29, exs. 4-36, 16 TTABVUE 9-10, 91-398, 17 TTABVUE 2-119.

Mark	Pertinent Goods
	Truck accessories, namely, tonneau covers, body side moldings, and fender flares. (Reg. No. 4898630)
	Motor vehicles, namely, automobiles and structural parts thereof. (Reg. No. 3671571)
	Automobiles, ... and structural parts thereof. (Reg. No. 1624722—also Lamborghini)
	Locks of metal for vehicles (Reg. No. 4169964)
	Automobile, All Terrain Vehicle and Side by Side All Terrain Vehicle bumpers, brush guards, and trailer hitches. (Reg. No. 4213998)
	Recreational vehicles, namely, towable trailers. (Reg. No. 5127865)
	Towing bar, tailgate, base plate and rock stopper, all for land vehicles. (Reg. No. 1778855)
	Vehicles, namely, utility vehicles and turf tractors. (Reg. No. 5509889)
	Vehicle bed with load lifting device. (Reg. No. 5391649).
	Utility task vehicles. (Reg. No. 5237247)
	Structural parts for land vehicles, vehicle parts, namely, motors. (Reg. No. 4908877)

	Vehicle wheel rims. (Reg. No. 4894178)
	Carts; land vehicles. (Reg. No. 4797664—Red Bull)
	Land vehicles and structural parts for land vehicles, namely, automobiles, trucks, brakes, brake parts, cam shafts, clutches, differentials, wheels, axles, transmissions, suspensions, axle shafts, axle assemblies. (Reg. No. 2385409)
	Land vehicle parts, namely, tire chains; Land vehicles; Motors and engines for land vehicles; Shaft couplings for land vehicles; Transmissions for land vehicles; Vehicle bodies. (Reg. No. 4651303)
	Cycles, motorcycles; parts of and accessories for cycles  (Reg. No. 4523764)
 <b>buffalo</b>	Machine parts, namely, bearings and bushings  (Reg. No. 3420636)
	Air cylinders, compression brakes, exhaust brakes, and retarders, all being for motor vehicles having internal combustion engines. (Reg. No. 2895322)
	Transmission, torque converters, axles and differentials for machines and replacement parts thereof for use in the mining, logging and construction industries. (Reg. No. 3783222—cancelled)
	Auto parts and accessories, namely, exterior insignia badges. (Reg. No. 2152610)
	Auto parts and accessories, namely, exterior insignia badges. (Reg. No. 2152609)
 <b>BullRing</b>	Aftermarket Vehicle Accessories, namely, truck bed stake pocket tie downs made from a combination of metal and plastic. (Reg. No. 5518406)

	<p>Detergents additives, fragrances, lubricants and deodorants for automobiles and rooms. (Reg. No. 5148399—cancelled)</p>
	<p>Protective cover for vehicle bumpers; fitted cover for vehicle bumpers. (Reg. No. 4477777)</p>
	<p>Bands for wheel hubs; Dump carts; Dump trucks; Shock absorbers for automobiles; Spoke clips for wheels; Trailer hitches for vehicles; Connecting rods for land vehicles, other than parts of motors and engines; Couplings for land vehicles; Engines for land vehicles; Motors for land vehicles; Transmission mechanisms, for land vehicles; Transmission shafts for land vehicles. (Reg. No. 5452234)</p>
	<p>Trailers; dump trailers; equipment trailers; gooseneck trailers; tilt trailers; truck beds, namely dump beds; deck over trailers. (Reg. No. 5754417)</p>
	<p>Land vehicles, automobiles, hoods for vehicles, automobile hoods, bodies for vehicles, automobile bodies, vehicle bumpers, bumpers for automobiles, vehicle running boards. (Reg. No. 5677177)</p>
	<p>Structural parts for automobiles. (Reg. No. 5432672)</p>
	<p>Wheels. (Reg. No. 4591852)</p>
	<p>Automotive after market parts for trucks, trailers, and heavy equipment vehicles only. (Reg. No. 3902518)</p>
	<p>Motor vehicle spare parts and accessories, namely, brakes and brake parts; suspension shock absorbers and components; steering apparatus, namely steering gears and steering wheels for vehicles.(Reg. No. 5477592—§ 66A basis)</p>
	<p>Roof racks; Vehicle bumpers; Vehicle hood and fender louvers and vents; Vehicle hoods. (Reg. No. 5569369)</p>
	<p>Vehicle tires. (Reg. No. 5292452)</p>



Vehicle wheels; wheel rims.  
(Reg. No. 4731185)

Applicant argues that the above are: “all registrations within the automotive industry, and which span the industry in a wide variety of products and services from automobiles, trucks, all-terrain vehicles, and parts for all forms of land vehicles. ... The foregoing registrations are extensive evidence of third-party use and registrations, and thus are powerful on their face regardless of the extent of the usage of these third-party registrations in the marketplace. *See Jack Wolfskin....*” Applicant concludes that, “The ubiquity of bovine-related marks indicates there is not a likelihood of confusion between Opposer’s Marks and K2’s Mark.”<sup>67</sup>

Applicant’s reliance on *Jack Wolfskin* is once again misplaced. In that case, the applicant adduced evidence of 87 third-party registrations of paw logos and 28 web page excerpts of the **use** of paw logos on clothing. The Federal Circuit characterized this as “voluminous evidence of paw print design elements that have been registered and **used** in connection with clothing....” *Jack Wolfskin*, 116 USPQ2d at 1136 (emphasis added). The Court continued:

Jack Wolfskin presented extensive evidence of third-party registrations depicting paw prints **and evidence of these marks being used in internet commerce for clothing**. ... [E]vidence of third-party **use** of similar marks on similar goods “can show that customers have been educated to distinguish between different marks on the basis of minute distinctions.” ... In this case, Jack Wolfskin’s evidence demonstrates the ubiquitous **use** of paw prints on clothing as source identifiers. Given the volume of evidence in the record, consumers are conditioned to look for differences between paw designs and additional indicia of origin to determine the source of a given product. Jack Wolfskin’s extensive evidence of third-party **uses** and registrations of paw prints indicates that

<sup>67</sup> Applicant’s brief, 23 TTABVUE 37-38.

consumers are not as likely confused by different, albeit similar looking, paw prints.

*Id.* (quoting *Juice Generation*, 115 USPQ2d at 1674, emphasis added).

But here, unlike *Jack Wolfskin*, Applicant has only submitted third-party **registrations**, with no corroborating evidence regarding their use in commerce. “Applicant’s citation of third-party registrations as evidence of market weakness is unavailing because third-party registrations standing alone, are not evidence that the registered marks are in use on a commercial scale, let alone that consumers have become so accustomed to seeing them in the marketplace that they have learned to distinguish among them by minor differences.” *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016) *quoted in Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, \*9 (TTAB 2020). The third-party registrations, with no evidence of the extent of their use in commerce, do not diminish the commercial strength of Opposer’s marks. *Id.* “We have frequently said that little weight is to be given such [third-party] registrations in evaluating whether there is likelihood of confusion. The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them...” *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) *quoted in In re Inn at St. John’s*, 126 USPQ2d at 1746 (TTAB 2018).<sup>68</sup>

Applicant’s third-party registration evidence suffers from other deficiencies, as well. As the Federal Circuit has emphasized, the relevant inquiry under the sixth

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<sup>68</sup> Furthermore, two of the third-party registrations—Reg. Nos. 5148399 and 3783222—are cancelled, so they have no probative value; and another two—Reg. Nos. 5477592 and 4929570—issued under Section 66A of the Trademark Act, do not prove exposure of the mark through use in commerce. *See In re Info. Builders*, 2020 USPQ2d 10444 at \*6 n. 19.

*DuPont* factor is the number and nature of **similar** marks on **similar** goods. *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693-94 (Fed. Cir. 2018) (citing *Century 21 Real Estate v. Century Life*, 23 USPQ2d at 1701). *See also Palm Bay*, 73 USPQ2d at 1693 (“Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”).

Over half of Applicant’s cited third-party marks are clearly dissimilar to Opposer’s bison logo. Many consist of steer skulls or bull heads, many rendered geometrically



and abstractly. And one is a warthog: . Moreover, many of these third-party marks add wording or design features that distinguish the marks from Opposer’s marks. *See In re Integrated Embedded*, 120 USPQ2d at 1513 (“The probative value of Applicant’s evidence is further diminished inasmuch as many of the third-party registrations, as discussed above, also include additional wording and design elements not found in the cited registration or involved application, that engender a different commercial impression from either mark.”); *Puma v. Garan*, 224 USPQ at 1066 (additional word or design features distinguish third party registered marks).

Opposer states that it does not take issue with any and all bovine designs, just those that resemble its registered marks. It is not necessary, as Opposer suggests, that the third-party marks be nearly precise replicas of its mark, “horned, bovine creatures positioned in a four-point stance and shown in a three-quarter perspective

view.”<sup>69</sup> The standard under the sixth *DuPont* factor is “similar” marks, bearing in mind that consumers retain “an overall or general impression of the many and various marks that exist in the marketplace.” *In re Info. Builders*, 2020 USPQ2d 10444 at \*7. But most of Applicant’s examples are clearly dissimilar.

Moreover, most of Applicant’s cited third-party registrations are for goods that are not as closely related to Opposer’s goods as Applicant’s goods. “[T]he controlling inquiry is the extent of third-party marks in use on ‘similar’ goods or services. . . . ‘It is less relevant that [the mark] is used on unrelated goods or services....’” *Omaha Steaks v. Greater Omaha Packing*, 128 USPQ2d at 1694. Earlier, Applicant argued that “[t]wo entities offering goods and services within a sweeping category such as automotive parts does not compel a finding that the goods are related.”<sup>70</sup> Yet now it cites third-party registrations variously identifying locks for vehicles, vehicle bed with load lifting device, parts and accessories for motor cycles, machine parts, air cylinders and compression brakes for motor vehicles, detergents, fragrances, lubricants and deodorants for automobiles, covers for vehicle bumpers, wheels, tires, and wheel rims. Most do not come as close as Applicant’s identified goods, which are identical or legally identical to Opposer’s goods.

In short, most of the third-party registrations do not have marks or goods as similar to Opposer’s registered marks as Applicant’s, *In re Info. Builders*, 2020 USPQ2d 10444 at \*8, and none are supported by evidence of their use in commerce. So Applicant has not shown that Opposer’s marks are commercially weak.

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<sup>69</sup> Opposer’s brief, 21 TTABVUE 47-49, Opposer’s reply brief, 25 TTABVUE 22.

<sup>70</sup> Applicant’s brief, 23 TTABVUE 22.

With respect to **conceptual** strength, however, *Jack Wolfskin* states:

[E]vidence of third-party registrations is relevant to show the sense in which a mark is used in ordinary parlance, ... that is, some segment that is common to both parties' marks may have a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak....

*Jack Wolfskin*, 116 USPQ2d at 1136 (citing *Juice Generation*, 115 USPQ2d at 1675) (internal punctuation omitted).

In this case, Applicant and Opposer both use bull or bison imagery to convey similar impressions to motorists seeking customized structural modifications for their vehicles. According to Applicant, its bull logo is “a symbol of the rugged, tough, and individualistic American spirit.”<sup>71</sup> According to Opposer, its bison logo “embodies the spirit of strength, adventure, and rugged wilderness....”<sup>72</sup> Similarly, the third-party registrations show that it is not uncommon for companies selling automotive parts to adopt and register marks with bison or bull imagery that carries a suggestive connotation of rugged durability and strength—i.e., that the automotive parts are “strong as a bull.” For example:



This frequent, common adoption of bull or bison designs by third parties, as evinced by their registrations, serves to show that the designs are suggestive of the rugged, strong, characteristics or qualities of auto parts. In that sense, this case is

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<sup>71</sup> Applicant’s brief, 23 TTABVUE 6; Ko decl. ¶ 5a, 16 TTABVUE 3.

<sup>72</sup> Messink decl. ¶13, 14 TTABVUE 6.

analogous to *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404, 1405 (TTAB 1988), where 170 third party registrations were introduced to show that a five-sided box-with-a-roof design “used with goods and services in the real estate field may be perceived as a design of a house.” *Id.* at 1406. The Board accordingly found that “[t]his element is suggestive of a key element involved in the real estate services of both applicant and opposer in the case at hand.” *Id.*, cited in 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:89, 11:90 (5th ed. March 2021 update).

Here, as in the *Red Carpet* case, Applicant’s third-party registrations do not diminish the commercial strength of Opposer’s marks, although they do undermine the conceptual or inherent strength of its bison design element to a degree, underscoring its suggestive nature. Even so, suggestive registered marks are entitled to protection against registration of confusingly similar marks—especially marks used on identical or legally identical goods. See *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982) cited in *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010)).

## **7. Actual Confusion**

Under the seventh and eighth *DuPont* factors, we consider the nature and extent of any actual confusion, in light of the length of time and conditions under which there has been contemporaneous use of the parties’ subject marks. *DuPont*, 177 USPQ at 567.

Applicant points to the absence of evidence of actual confusion in the record, observing that “[a]lthough proof of actual confusion is not necessary to show

likelihood of confusion, its absence can strongly reinforce a conclusion of no likelihood of confusion reached by the analysis of the other relevant *DuPont* factors.”<sup>73</sup> Applicant’s Sales Director declares that since Applicant began using its mark in the marketplace in July 2018, he has never encountered or heard of an incident of consumer confusion with Opposer’s marks, either at the trade show where both parties promoted their brands, or otherwise.<sup>74</sup> The Director of Vendor Management for AutoAnything agrees, declaring that he did not personally experience any confusion in viewing the parties’ marks, and that he has never encountered or heard of agents of AutoAnything or Morris 4x4 Center experiencing or reporting instances of confusion between the marks.<sup>75</sup> He concludes that “[i]n my experience, there has been a complete absence of any real such actual confusion occurring on the AutoAnything and Morris 4x4 Center Platforms despite both the Bulken Marks and the AEV Marks co-existing for over two years.”<sup>76</sup> From this testimony, Applicant concludes: “[T]hose who are well-versed in the marketplace of automobile and off-road parts view the likelihood that any confusion would occur whatsoever between the Opposer’s Marks and K2’s Mark as de minimis, and realistically, perceive that actual confusion between Opposer’s Marks and K2’s Marks will never occur.”<sup>77</sup>

As Opposer correctly notes, however, the test under Section 2(d) is not actual confusion but likelihood of confusion. *Weiss Associates Inc. v. HRL Associates Inc.*,

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<sup>73</sup> Applicant’s brief, 23 TTABVUE 38.

<sup>74</sup> Ko decl. ¶¶ 30-31, 36, 16 TTABVUE 10-11.

<sup>75</sup> Morris decl. ¶ 21, 24-25, 15 TTABVUE 7-8.

<sup>76</sup> Morris decl. ¶ 26, 15 TTABVUE 8.

<sup>77</sup> Applicant’s brief, 23 TTABVUE 38-39.

902 F.2d 1546, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990). Likelihood of confusion is judged from the perspective of the average consumer, *UMG v. Mattel*, 100 USPQ2d at 1885, in this case, ordinary motorists seeking customized structural modifications for their vehicles. It is not judged from the perspective of a retailer, who would be familiar with the differing manufacturers of goods, irrespective of their brands. *In re Teradata Corp.*, 223 USPQ 361, 362 (TTAB 1984) (“we are concerned only with the mark itself and must not presume that a purchaser would be aware of the identity of the manufacturer of goods bearing that mark....”). Nor is it judged from the perspective of Applicant’s officer, whose testimony is, to say the least, self-serving. *See In re Bisset-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529-30 (CCPA 1973) (stating that self-serving testimony of applicant’s corporate president’s unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion) *cited in In re Cook Med. Techs. LLC*, 105 USPQ2d 1377, 1383-84 (TTAB 2012).

The seventh and eighth *DuPont* factors require us to look at actual market conditions, to the extent there is evidence of such conditions of record. *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, \*6 (TTAB 2020). As the Board has declared:

The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by applicant of its mark for a significant period of time in the same markets as those served by opposer under its marks. *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred)....

*Citigroup Inc. v. Capital City Bk Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 98 USPQ2d 1253 (Fed. Cir. 2011).

In this case, Applicant began using its mark in July 2018, so the parties have used their marks contemporaneously for only two to three years. This falls far short of the “significant period of time” required for the absence of actual confusion to be probative. *Compare Tao v. Bender*, 125 USPQ2d at 1063 (only two years’ contemporaneous sales to end consumers) and *Primrose Ret. v. Edward Rose Senior Living*, 122 USPQ2d at 1039-40 (only three years’ contemporaneous use of marks) with *Christian Broad. Network, Inc. v. ABS-CBN Int’l*, 84 USPQ2d 1560, 1570 (TTAB 2007) (“considerable activity by the parties under their respective marks over a long period of time [13 years] without any reported instances of confusion” tended to “reinforce the lack of a likelihood of confusion”) and *Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co.*, 781 F.2d 884, 228 USPQ 364, 367 (Fed. Cir. 1986) (while lack of evidence of confusion is not dispositive, the concurrent use of the marks for 19 years without any reported instances of confusion suggests that the marks are not likely to cause confusion).

Furthermore, Applicant, unlike Opposer, has not adduced evidence of the extent of its sales and advertising, so we are at a disadvantage to gauge the opportunity for actual confusion to have occurred. *See Cunningham v. Laser Golf*, 55 USPQ2d at 1847. Aside from the parties’ marketing and promotion on AutoAnything and at a trade show, there is no evidence of a meaningful opportunity for actual confusion to have occurred. *See Nina Ricci S.A.R.L. v. E.T.F. Enters. Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) (“The absence of any showing of actual confusion

is of very little, if any, probative value” where evidence of as to the use of Applicant’s merchandise during the time in question was not presented) *quoted in Double Coin Holdings. v. Tru*, 2019 USPQ2d 377409 at \*9.

Consequently, the seventh and eighth *DuPont* factors are neutral.

### **C. Summary**

As we apply the *DuPont* factors, we bear in mind that the overriding purposes of Section 2(d) are to prevent buyer confusion as to the source of the goods or services, and to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *In re Country Oven*, 2019 USPQ2d 443903, \*2-3 (TTAB 2019) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993)).

When we consider the record, the relevant likelihood of confusion factors, and all of the parties’ arguments and evidence relating thereto, we conclude that the *DuPont* factors concerning the similarity of the marks, goods and services, channels of trade, and commercial strength of Opposer’s marks support a finding of a likelihood of confusion. These factors outweigh the factors concerning customer care and diminution of the conceptual strength of Opposer’s bison logo. The factors concerning actual confusion during contemporaneous use in commerce are neutral.

Consequently, relevant consumers familiar with Opposer’s goods and services offered under its registered marks would be likely to believe, upon encountering the goods offered under Applicant’s design mark, that the goods originated with or are associated with or sponsored by the same entity. There is therefore a likelihood of confusion under Section 2(d) of the Trademark Act. 15 U.S.C. § 1052(d).

#### **IV. Decision**

The opposition to Application Serial No. 88197871 is sustained on the ground of likelihood of confusion under Section 2(d), and registration to Applicant is refused.

In view of our decision, we need not reach the claims of dilution by blurring or tarnishment. *See Venture Out Props. LLC. v. Wynn Resorts Holdings, LLC*, 81 USPQ2d 1887, 1894 (TTAB 2007).